



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

16

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,950	09/11/2003	Shawn O'Donnell	21863-000100	7016
20350	7590	10/28/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	
DATE MAILED: 10/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,950	O'DONNELL, SHAWN	
	Examiner Maikhahan Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/29/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***DETAILED ACTION***

1. This action is responsive to communications: original application filed 09/11/2003. IDS filed 03/29/2004.
2. Claims 1-18 are currently pending in this application. Claims 1, 5, 7, 11, 13, and 17 are independent claims.
3. It is noted that the cross reference related to the application cited in the specification must be updated (i.e., update the relevant status, on page 1, line 5). Appropriate correction is required.

***Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
  
A person shall be entitled to a patent unless -

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)*

5. Claims 5-6, 11-12, and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by **Rawat et al.** (U.S. 6,662,340, filed 05/2002, as cited by Applicant's IDS, filed 03/29/2004)

**As to claim 5**

Rawat teaches a computer-implemented method of processing electronic forms (*examines electronic documents; see Abstract*), the method comprising:

- a. displaying a first electronic form (*HTML form 100; col.4, line 28 and see fig.1*),  
the first electronic form comprising at least a first field (*a plurality of fields; col.4, lines 28-29 and see fig.1*), when a first descriptor is associated with the first field (*field labels 102, in which each label is spatially and visually related to its corresponding field; col.4, lines 42-45 and see fig.1*);
- b. determining first information entered in the first field on the first electronic form (*see the filling form discussion beginning at col.4, line 30 and col.10, lines 13-15*); and
- c. storing information for a user (*the user profile is stored; col.5, lines 45-55*)  
indicating that the first information was entered in a field associated with the first descriptor (*mapping each identified form element to the correct user data be filled into each field; col.5, lines 52-56*).

**As to claim 6**

Rawat teaches receiving information identifying a second electronic form (*see fig.1 and see the quick checkout form discussion beginning at col.4, line 28 and col.5, lines 27-32*); determining a set of descriptors (*field labels, field names*) associated with a set of fields (*related to its corresponding field*) included in the second electronic form (*electronic forms*), the set of descriptors including the first descriptor; and displaying the second

electronic form on a computer display such that the first information is displayed in the field of the second electronic form associated with the first descriptor (*see fig.2*).

**As to claim 11**

Refer to claim 5 above. Claim 11 is the same as claim 5, except claim 11 is a computer program product claim and claim 5 is a method claim.

**As to claim 12**

It includes the same limitations as in claim 6 above, and is similar rejected under the same rationale.

**As to claim 17**

Refer to claim 5 above. Claim 17 is the same as claim 5, except claim 17 is a system claim and claim 5 is a method claim (*it is noted that a processor, an output device; and a memory are inherent to the system of Rawat*).

**As to claim 18**

It includes the same limitations as in claim 6 above, and is similar rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

7. Claims 1-4, 7-10, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rawat et al.** in view of **Maxwell et al.** (U.S. 6,589,290, filed 10/1999).

**As to claim 1**

- a. Rawat teaches a computer-implemented method of processing electronic forms (*see Abstract*), the method comprising:
- (i) receiving information identifying a first electronic form (*see fig.1 and see the quick checkout form discussion beginning at col.4, line 28 and col.5, lines 27-32*);
  - (ii) determining a set of descriptors (*field labels, field names*) associated with a set of fields (*fields*) included in the first electronic form, the set of descriptors including a first descriptor associated with a first field (*each label is spatially and visually related to its corresponding field*) (*col.4, lines 31-62*);
  - (iii) accessing user information comprising information identifying a set of identifiers stored for a user, the set of identifiers stored for the user including a first identifier corresponding to the first descriptor, wherein a first value is associated with the first identifier (*col.5, line 52-col.6, line 22*);
  - (iv) displaying the first electronic form on a computer display such that the first value is displayed in the first field of the first electronic form (*see fig.1 and the associated text*);

- (v) identifying at least a second descriptor associated with a field in the first electronic form (*see fig.1 and accompanying text beginning at col.4, line 30*) that does not have a corresponding identifier in the set of identifiers stored for the user;
  - (vi) determining a second value entered in the field associated with the second descriptor (*col.4, lines 43-62*); and
  - (vii) including an identifier corresponding to the second descriptor in the set of identifiers stored for the user, wherein the second value is associated with the identifier corresponding to the second descriptor (*col.7, lines 40-67*).
- b. Rawat, however, does not specifically teach “*the electronic form that does not have a corresponding identifier in the set of identifiers stored for the user.*”
- c. Maxwell teaches the electronic form that does not have a corresponding identifier in the set of identifiers stored for the user (*col.14, lines 29-61*).
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Maxwell in the system of Rawat because it would have provided the capability for filling out electronic forms without the requirement of any prior mapping or examinations of the forms.

### **As to claim 2**

Rawat teaches the set of descriptors associated with the set of fields included in the first electronic form include field names associated with the set of fields and the set of identifiers stored for the user comprise one or more field names associated with the set of fields (*col.4, lines 38-62*).

**As to claim 3**

Refer to the discussion of claim 6 above for rejection.

**As to claim 4**

- a. Rawat teaches determining a third value entered in the first field of the first electronic form that is different from the first value (*see fig.2*). However, does not specifically teach “*updating the user information such that the third value is associated with the first identifier.*”
- b. Maxwell teaches updating the user information such that the third value is associated with the first identifier (*col.15, lines 5- 56 and col.17, lines 1-18*).
- c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Maxwell in the system of Rawat because it would have provided the capability for

**As to claim 7**

Refer to claim 1 above. Claim 7 is the same as claim 1, except claim 7 is a computer program product claim and claim 1 is a method claim.

**As to claim 8**

It includes the same limitations as in claim 2 above, and is similar rejected under the same rationale.

**As to claim 9**

Refer to the discussion of claim 6 above for rejection.

**As to claim 10**

It includes the same limitations as in claim 4 above, and is similar rejected under the same rationale.

**As to claim 13**

Refer to claim 1 above. Claim 13 is the same as claim 1, except claim 13 is a system claim and claim 1 is a method claim. Additionally, Rawat further teaches a communication network; a first computer; and a second computer (*see fig. 3*).

**As to claims 14-16**

They include the same limitations as in claims 2-4 above, and are similar rejected under the same rationale.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hitchcock et al.	U.S. Patent No. 6,460,042	issued: Oct. 1, 2002
Markus et al.	U.S. Patent No. 6,499,042	issued: Dec. 24, 2002
DASWANI et al.	U.S. Publication 2002/0023108 A1	Pub. Date: Feb. 21, 2002
Malcolm et al.	U.S. Publication 2002/0165877 A1	Pub. Date: Nov. 7, 2002
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

Art Unit: 2176

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

*William S. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
*10/26/2005*